



Docket No.: 0303-0491PUS1
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Haruki KODAMA et al.

Application No.: 10/513,964

Confirmation No.: 9792

Filed: November 10, 2004

Art Unit: 1775

For: CAST-IRON INSERT AND METHOD OF
MANUFACTURING SAME

Examiner: J. J. Zimmerman

INFORMATION DISCLOSURE STATEMENT
(SUBMISSION AFTER FILING OF AN APPLICATION BUT BEFORE FINAL
REJECTION OR NOTICE OF ALLOWANCE OR CONCURRENTLY WITH A RULE
1.114 RCE APPLICATION)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to 37 C.F.R. §§ 1.97 and 1.98, applicant(s) hereby submit(s) an Information Disclosure Statement for consideration by the Examiner.

I. LIST OF PATENTS, PUBLICATIONS OR OTHER INFORMATION

The patents, publications, or other information submitted for consideration by the Office are listed on the PTO-SB08(s), attached hereto.

II. COPIES

- a. Copies of cited U.S. patents and patent application publications are not included.
Copies of foreign patent documents and non-patent literature are included.

- b. Some or all of the documents listed on the PTO-SB08 are not enclosed because they were cited in the International Search Report and copies should already be in the PTO file. If copies are needed, please contact the undersigned.
- c. REFERENCES PREVIOUSLY CITED OR SUBMITTED - Pursuant to 37 C.F.R. §1.98(d), consideration of information listed on the PTO-SB08 form(s) is requested since any patents, publications, or other information which are listed on the PTO-SB08 form(s) but for which copies are not enclosed herewith, were previously cited by or submitted to the PTO in one of the following applications which has been relied upon for an earlier filing date under 35 U.S.C. § 120:

III. CONCISE EXPLANATION OF THE RELEVANCE

(check at least one box)

- a. DOCUMENTS IN THE ENGLISH LANGUAGE - The patents, publications, or other information listed on the attached PTO SB08 are in the English language and therefore, do not require a statement of relevancy.
- b. DOCUMENTS NOT IN THE ENGLISH LANGUAGE - A concise explanation of the relevance of all patents, publications, or other information listed that is not in the English language is as follows: An English language abstract is provided for JP 3-447-A and JP 50-110929-A.
- c. ENGLISH LANGUAGE SEARCH REPORT - An English language version of the search report or action that indicates the degree of relevance found by the foreign office is attached, thereby satisfying the requirement for a concise explanation. See MPEP 609(III)(A)(3).
- d. OTHER - The following additional information is provided for the Examiner's consideration. Two Japanese Office Actions respectively mailed on December 12, 2006 are attached hereto with an English translation of the pertinent portions.

IV. FEES (check one box)

- a. This Information Disclosure Statement is being filed concurrently with the filing of a new patent application; therefore, no fee is required.
- b. This Information Disclosure Statement is being filed concurrent with the filing of a continuation-in-part, continuation, or divisional patent application; therefore, no fee is required.
- c. This Information Disclosure Statement is being filed within three months of the filing date of a national application (37 C.F.R. § 1.97(b)(1)). No fee or statement is required.
(This section is not to be used with RCE's.)
- d. This Information Disclosure Statement is being filed within three months of the date of entry of the national stage as set forth in § 1.491 in an international application (37 C.F.R. § 1.97(b)(2)). No fee or statement is required.
- e. This Information Disclosure Statement is being filed concurrently with the filing of a Request for Continued Examination under § 1.114 (37 C.F.R. § 1.97(b)(4)). No fee or statement is required.
- f. This Information Disclosure Statement is being filed before the mailing date of a first Action on the merits (37 C.F.R. § 1.97(b)(3)). No fee or statement is required. In the event that a first Office Action on the merits has been issued, please consider this IDS under 37 C.F.R. § 1.97(c) and see the statement under 37 C.F.R. § 1.97(e) below, or, if no statement has been made, charge our deposit account for the fee as required by 37 C.F.R. § 1.17(p).
- g. This Information Disclosure Statement is being filed before the mailing date of a Final Office Action under 37 C.F.R. § 1.113 (See 37 C.F.R. § 1.97(c)(1)) or before the mailing date of a Notice of Allowance under 37 C.F.R. § 1.311 (See 37 C.F.R. § 1.97(c)(2)).
- No statement; therefore, a fee as required by 37 C.F.R. § 1.17(p) is attached.

or

See the statement below. No fee is required.

V. STATEMENT UNDER 37 C.F.R. § 1.97(e)

(check only one box)

The undersigned hereby states that:

- a. Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than 30 days prior to the filing of this IDS; or
- b. Each item of information contained in the IDS was first cited in any communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS; or
- c. No item of information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application, and, to the knowledge of the person signing the certification after making reasonable inquiry, no item of IDS was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of the IDS.
- d. Some of the items of information were cited in a communication from a foreign Patent Office. As to this information, the undersigned states that each item of information contained in the IDS was first cited in a communication from a foreign Patent Office in a counterpart foreign application not more than three months prior to the filing of this IDS. As to the remaining information, the undersigned hereby states that no item of this remaining information contained in the IDS was cited in a communication from a foreign Patent Office in a counterpart foreign application and, to the best of my knowledge after making reasonable inquiry, was known to any individual designated in 37 C.F.R. § 1.56(c) more than three months prior to the filing of this statement.

VI. PAYMENT OF FEES (check one box)

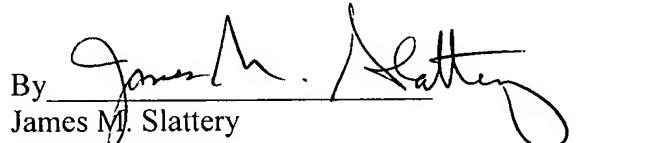
- The required fee is listed on the attached Fee Transmittal.
- No fee is required.

If the Examiner has any questions concerning this IDS, he/she is requested to contact the undersigned. If it is determined that this IDS has been filed under the wrong rule, the PTO is requested to consider this IDS under the proper rule and charge the appropriate fee to Deposit Account No. 02-2448.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

Dated: January 29, 2007

Respectfully submitted,

By 
James M. Slattery
Registration No.: 28,380
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicant

Attachment(s):

- PTO-SB08
 Documents
 Japanese Office Actions
 Fee
 Other:



PTO/SB/08A/B (09-06)

Approved for use through 03/31/2007. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Substitute for form 1449/PTO

INFORMATION DISCLOSURE STATEMENT BY APPLICANT

(Use as many sheets as necessary)

Sheet 1 of 1				Complete if Known	
				Application Number	10/513,964-Conf. #9792
				Filing Date	November 10, 2004
				First Named Inventor	Haruki KODAMA
				Art Unit	1775
				Examiner Name	J. J. Zimmerman
				Attorney Docket Number	0303-0491PUS1

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Document Number	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		Number-Kind Code ² (if known)			

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No. ¹	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T ⁶
		Country Code ³ -Number ⁴ -Kind Code ⁵ (if known)				
BA	JP-50-110929-A		09-01-1975			
BB	JP-3-000447-A		01-07-1991			

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. ¹ Applicant's unique citation designation number (optional). ² See Kinds Codes of USPTO Patent Documents at www.uspto.gov or MPEP 901.04. ³ Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). ⁴ For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. ⁵ Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. ⁶ Applicant is to place a check mark here if English language Translation is attached.

NON PATENT LITERATURE DOCUMENTS

Examiner Initials	Cite No. ¹	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²

*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

Examiner Signature	Date Considered
--------------------	-----------------

BIRCH, STEWART, KOLASCH & BIRCH, LLP

INTELLECTUAL PROPERTY LAW

JAMES M. SLATTERY
MICHAEL K. MUTTER
CHARLES GORENSTEIN
GERALD M. MURPHY, JR.
LEONARD R. SVENSSON
ANDREW D. MEIKLE
MARC S. WEINER
JOE MCKINNEY MUNCY
ROBERT J. KENNEY
JOHN W. BAILEY
MARK J. NUELL, PH.D.
JAMES T. ELLER, JR.
D. RICHARD ANDERSON
MICHAEL R. CAMMARATA
PAUL C. LEWIS
MARYANNE ARMSTRONG, PH.D.
QUENTIN R. "RICK" CORRIE
ESTHER H. CHONG
CRAIG A. MCROBBIE

OF COUNSEL:
THOMAS M. SMALL*
WILLIAM L. GATES*
F. PRINCE BUTLER
FRED S. WHISENHUNT (RET.)
JAMES W. HELLEWEGE
ROBERT F. GNOSSE
ROBERT J. WEBSTER
EDWARD J. WISE

8110 GATEHOUSE ROAD
SUITE 100 EAST
FALLS CHURCH, VA 22042-1248
USA

(703) 205-8000
FAX: (703) 205-8050
(703) 698-8590 (G IV)

e-mail: mailroom@bskb.com
web: <http://www.bskb.com>

CALIFORNIA OFFICE:
SAN DIEGO, CALIFORNIA

SENIOR COUNSEL:
TERRELL C. BIRCH
RAYMOND C. STEWART
JOSEPH A. KOLASCH

EXECUTIVE ADVISOR:
NICHOLAS P. GODICI

RICHARD CALLAGHER
CATHERINE M. VOISINET*
EUGENE T. PEREZ
CAROLYN T. BAUMGARDNER*
GARTH M. DAHLEN, PH.D.
SUSAN W. GORMAN, PH.D.*
SCOTT T. WAKEMAN
CHAD J. BILLINGS
J. MARK KONIECZNY, PH.D.
DAVID A. BILODEAU
GREG HSU
THOMAS J. SIEPMANN, PH.D.
PENNY L. CAUDLE
JASON W. RHODES
CHAD D. WELLS
LAURA R. LUTZ*
ALI M. IMAM*
MONIQUE T. COLE

REG. PATENT AGENTS:
FREDERICK R. HANDREN
MAKI HATSUMI
ROBERT W. DOWNS
CARL T. THOMSEN

*ADMITTED TO A BAR OTHER THAN VA

January 29, 2007

By Facsimile
011 81 3 3320 1393

Mr. Yoshihiro Chiba
TOHO INTERNATIONAL Patent & Law Office
Shinjuku Maynds Tower 16F
1-1, Yoyogi 2-chome, Shibuya-ku
Tokyo
151-0053
JAPAN

PRIVILEGED AND CONFIDENTIAL:
ATTORNEY-CLIENT COMMUNICATION

Re: Haruki KODAMA et al. - Appl. No. 10/513,964
Title: CAST-IRON INSERT AND METHOD OF MANUFACTURING SAME
Your Ref.: 03P022HE-USPO/ss - Our Ref.: 0303-0491PUS1

Dear Mr. Chiba:

Pursuant to your letter dated December 26, 2006, we prepared and filed an Information Disclosure Statement in the U. S. Patent and Trademark Office on January 29, 2007. Two (2) copies are enclosed for your information and files.

As you will note, we have filed the attached Information Disclosure Statement with a certification under 37 C.F.R. Section 1.97(e)(2) that the references were first discovered due to citation Japanese office actions. If the certification is incorrect please contact us immediately so that the certification may be withdrawn to avoid any appearance of impropriety on the part of the applicant.

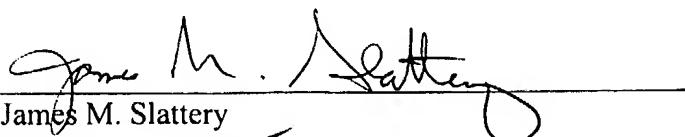
Mr. Yoshihiro Chiba
January 29, 2007
Page 2

PRIVILEGED AND CONFIDENTIAL:
ATTORNEY-CLIENT COMMUNICATION

We shall keep you advised of further developments as they occur. Our Debit No. 737232 is enclosed.

Very truly yours,

BIRCH, STEWART, KOLASCH & BIRCH, LLP


James M. Slattery

JMS/CTT/srm ~~OK~~
Enclosures: Information Disclosure Statement - Two (2) copies
Debit No. 737232